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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,533	08/04/2003	Robert R. Burnside	2024729-7034533001	6061

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EXAMINER	
CHARIOUI, MOHAMED	

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/634,533	BURNSIDE ET AL.	
	Examiner	Art Unit	
	Mohamed Charioui	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant cancelled claims 1-42.

Claim Objections

2. **Claim 49** is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 48. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 58 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 57. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 43 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,611,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of the probe usage indicator is not necessary to determine whether the medical probe had been exposed to a sterilization cycle. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use only the sterilization indicator to determine whether or not the medical probe had been exposed to a sterilization cycle. Thus it would be more cost effective to only use the sterilization indicator to determine the sterilization status of the medical probe.

Claim 44 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,611,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of the probe usage indicator is not necessary to determine the presence of probe sterilization indicator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use only the presence of the sterilization indicator to prevent the operation of the medical probe. Thus it would be more cost effective to only use the sterilization indicator to determine the sterilization status of the medical probe and therefore determining whether or nor not the operation of the medical probe should be prevented.

Claim 45 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,611,793.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of the probe usage indicator is not necessary to determine the absence of probe sterilization indicator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use only the sterilization indicator to determine the sterilization status of the medical probe. Thus, it would be more cost effective to only use the sterilization indicator to determine the sterilization status of the medical probe and therefore determining whether or nor not the operation of the medical probe should be allowed.

Claim 46 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 37 of U.S. Patent No. 6,611,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the connection of the probe usage indicator to the control unit is not necessary to determine the presence of probe sterilization indicator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to only connect the sterilization indicator to the control unit to determine the sterilization status of the medical probe. Thus it would be more cost effective to only connect the sterilization indicator to the control unit to determine the sterilization status of the medical probe.

Claim 53 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,611,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of the probe usage indicator is not necessary to

determine whether the presence of the medical probe sterilization indicator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use only the sterilization indicator to determine the sterilization status of the medical probe. Thus it would be more cost effective to only use the sterilization indicator to determine the sterilization status of the medical probe.

Claim 54 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,611,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of the probe usage indicator is not necessary to determine the presence of probe sterilization indicator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use only the sterilization indicator to determine if the medical probe sterilization indicator is present. Thus it would be more cost effective to only use the sterilization indicator to determine the sterilization status of the medical probe and therefore determine whether or nor not the operation of the medical probe should be prevented.

Claim 55 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,611,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presence of the probe usage indicator is not necessary to determine the absence of probe sterilization indicator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use only the sterilization indicator to determine the sterilization status of the medical probe.

Thus it would be more cost effective to only use the sterilization indicator to determine the sterilization status of the medical probe and therefore determine whether or nor not the operation of the medical probe should be allowed.

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 47 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claims 48 and 49 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 50 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 51 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 52 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 56 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claims 57 and 58 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 59 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 60 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 61 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 18 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Claim 62 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 20 of prior U.S. Patent No. 6,611,793. This is a double patenting rejection.

Prior art

5. The prior art made record and not relied upon is considered pertinent to applicant's disclosure:

Hughes ['187] discloses reusable steam test pack.

Bolea ['591] discloses system for measuring the efficacy of a sterilization cycle.

Kirckof ['890] discloses machine readable sterilization indicator for monitoring articles to be sterilized.

Denen et al. ['267] disclose Local in-device memory feature for electrically powered medical equipment.

Chin et al. ['375] disclose reusable medical device with usage memory, system using same.

Contact information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed Charioui whose telephone number is (571) 272-2213. The examiner can normally be reached Monday through Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S Hoff can be reached on (571) 272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohamed Charioui

3/31/04

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